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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,545	11/03/2000	Peter T. Aylward	79797PAL	8710

1333 7590 02/28/2003

PATENT LEGAL STAFF
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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

1009705545

Applicant(s)

Ayward et al

Examiner

AL Schilling

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2-19-03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22-28, 33-37, 39-44 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-28, 33-37, 39-44 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. Claims 22-28, 33-37, 39 and 42-44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 22 requires the upper shield layer to have a roughness between .01 and .06 micrometers at a spatial frequency of between .03 and 6.35 millimeters. However, the specification on page 9, lines 9-17, and page 13, lines 3-9 discloses roughness values for the upper shield layer of between .1 and .65 micrometers at the same spatial frequency. The specification does not disclose a roughness for the upper shield layer of between .01 and .06 micrometers. It is unclear from the specification as to whether or not applicants intend to claim elements with upper shield layers as set forth in the instant claims having the very smooth surfaces as required by the instant claims since these smooth surfaces are not disclosed in the specification. Also, added claims 42-44 disclose the addition of matting agents disclosed in the specification as being used to increase roughness of the upper shield layers to values disclosed on pages 9 and 13 of between .1 and .65 micrometers.

2. Claims 42-44 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. The specification fails to disclose elements with upper shield roughness values required by the instant claims

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63 containing silica, pigment or polymer beads since the use of silica, pigments and polymer beads in upper shield layers are only disclosed in the specification for providing rougher surfaces as now required by the instant claims. The ^{toughness} ~~reference~~ values of independent claim 22 are supported by original claim 3 but the smooth surfaces set forth in instant claim 3 are not disclosed in the original specification or claims as being used for upper shield layers containing silica, pigments or polymer beads which are disclosed in the specification as providing rough surfaces.

3. Claims 22-28, 33-37 and 39-43 are rejected under 35 U.S.C. § 102(e) as being anticipated by Aylward et al. for the same reasons as set forth in item No. 5 of the last Office action filed November 12, 2002. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. Claims 40 and 41 were intended to be included in this rejection over Aylward et al. in the last Office action. Aylward et al. discloses folding their imaged elements with transparent

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polymers and shield layers around a base as required by claims 40 and 41. Aylward et al. (see particularly column 7, line 65 - column 8, line 35) discloses upper shield layers on transparent polymer supports with roughness values as set forth on pages 9 and 13 of applicants' specification. Aylward et al. do not disclose the smooth upper shield layers required by the instant claims with low roughness values. This rejection is provisional as to claims 22-28, 33-37, 39, 42 and 43 and depends upon amending the roughness values of the instant claims to correspond to the roughness values disclosed in the specification. Claims 40 and 41 do not require the particular roughness values for the upper shield layers. In regard to claim 43, the silica of Aylward et al. is considered to be a pigment. Claim 44 is not rejected over Aylward et al. since Aylward et al. does not disclose the use of polymeric beads in their upper protective shield layers. A 35 U.S.C. § 103 rejection using prior art available only under 35 U.S.C. § 102, paragraph (e), is improper if common assignment exists. However, a 35 U.S.C. § 102, paragraph (e), rejection is still proper even if common assignment exists.

4. Claims 22-28, 33-37, 39 and 42-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Trautweiler et al., Tingler et al. '014 and Tingler et al. '505

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for the same reasons as set forth in paragraphs 1 and 4 of the last Office action filed November 12, 2002.

5. Claims 22-28, 33-37, 39 and 42-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of European Patent Publication 1003073 with Tingler et al. '014 and Tingler et al. '505 for the same reasons as set forth in paragraphs 2 and 4 of the last Office action.

6. Applicants' arguments filed February 19, 2003 have been fully considered but they are not deemed to be persuasive. Applicants' argument that the two Tingler et al. patents do not set forth protective layers with matte particles and surface roughness values as set forth by the instant claims is unconvincing. As explained in paragraph 1 above, the actual surface roughness values intended to be claimed are indefinite. Also, Tingler et al. '014 (column 8, lines 27-40) disclose the use of matte particles in their protective layers. Tingler et al. '505 (see particularly column 10, line 38 - column 11, line 10; Examples 1-6) disclose that their protective top coats preferably contain matte particles to provide rough surfaces which are important for improving the transport properties of the film during manufacturing and processing. Therefore, it would be obvious to one skilled in the art to use matting agents in the protective layers of the two Tingler et al. patents used to protect antistatic layers on the surfaces of transparent supports

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for photographic films as in Trautweiler et al. and the European patent publication for improving the transport of the film during manufacturing and processing. The remainder of applicants' arguments are believed to be answered in paragraph 4 of the last Office action. While the prior art does not disclose fingerprint protection, one skilled in the art would still be motivated to use antistatic layers in the photographic elements of the European patent publication and Trautweiler et al. in order to protect against static and to use protective layers on the antistatic layers to provide protection to the antistatic layers with the protective layers having necessary roughness provided by matting agents for transport during manufacturing and processing. The instant claims would be allowable if antistatic layers were excluded from being present intermediate the transparent polymer sheets and upper protective shield layers.

7. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (703) 308-4403.

RLSchilling:cdc

February 26, 2003

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 4103-1752

